

REMARKS

Claims 11 to 20 are now pending in the present application.

It is respectfully submitted that all of the presently pending claims are allowable, and reconsideration is respectfully requested.

Applicants thank the Examiner for considering the previously filed Information Disclosure Statement, PTO 1449 paper and cited references.

As to the claim for the priority application, the present case is not a convention application, but is a U.S. National phase application of the International application PCT/EP2005/052094, which was filed on May 10, 2005, and which claimed -- and claims -- priority to German patent application DE 10 2004 030 795.4, filed on June 25, 2004.

The Patent Office's own internal documents show (as does the face of the Office Action) that the certified priority German patent application was received by the U.S.P.T.O from the International Authority.

While paragraph one (1) of the Office Action is not understood, applicant again claims priority to priority German patent application DE 10 2004 030 795.4, filed on June 25, 2004. It is believed that this should satisfy the Examiner. If not, it is respectfully requested that the Examiner explain what is needed and why it is needed.

Claims 11 to 19 were rejected under 35 U.S.C. 102(a) as being anticipated by U.S. Patent Application Publication No. 2007/0010927 A1 ("Rowley").

As regards the anticipation rejections of the claims, to reject a claim under 35 U.S.C. § 102(a), the Office must demonstrate that each and every claim feature is identically described or contained in a single prior art reference. (*See Scripps Clinic & Research Foundation v. Genentech, Inc.*, 18 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 1991)). As explained herein, it is respectfully submitted that the Office Action does not meet this standard, for example, as to all of the features of the claims. Still further, not only must each of the claim features be identically described, an anticipatory reference must also enable a person having ordinary skill in the art to practice the claimed subject matter. (*See Akzo, N.V. v. U.S.I.T.C.*, 1 U.S.P.Q.2d 1241, 1245 (Fed. Cir. 1986)).

As further regards the anticipation rejections, to the extent that the Office Action may be relying on the inherency doctrine, it is respectfully submitted that to rely on inherency, the Office must provide a "basis in fact and/or technical reasoning to reasonably support the

determination that the allegedly inherent characteristics necessarily flows from the teachings of the applied art.” (See M.P.E.P. § 2112; emphasis in original; and see *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Int’f. 1990)). Thus, the M.P.E.P. and the case law make clear that simply because a certain result or characteristic may occur in the prior art does not establish the inherency of that result or characteristic.

The applied Rowley reference only has an effective priority date of its filing date of September 6, 2006. This is because it is a continuation-in-part application of application 10/689,812, filed on October 20, 2003, now U.S. Patent No. 6,950,737. However, the Examiner cites material in paragraphs 37 to 42 of the Rowley reference, which is simply and plainly missing from its parent case, U.S. Patent No. 6,950,737. In contrast, the present application is a U.S. National phase application of PCT/EP2005/052094, which has a filing date of May 10, 2005. Accordingly, the applied Rowley reference is not prior art as to the present application.

Accordingly, claims 11 to 19 are allowable over the “Rowley” reference.

Claim 20 was rejected under 35 U.S.C. § 103(a) as being unpatentable over the “Rowley” reference in view of U.S. Patent Application Publication No. 2005/0236896 A1 (“Offerle”).

To reject a claim under 35 U.S.C. § 103(a), the Office bears the initial burden of presenting a *prima facie* case of obviousness. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993). To establish *prima facie* obviousness, three criteria must be satisfied. First, there must be some suggestion or motivation to modify or combine reference teachings. *In re Fine*, 837 F.2d 1071, 5 U.S.P.Q.2d 1596 (Fed. Cir. 1988). This teaching or suggestion to make the claimed combination must be found in the prior art and not based on the application disclosure. *In re Vaeck*, 947 F.2d 488, 20 U.S.P.Q.2d 1438 (Fed. Cir. 1991).

Also, as clearly indicated by the Supreme Court in *KSR*, it is “important to identify a reason that would have prompted a person of ordinary skill in the relevant field to combine the [prior art] elements” in the manner claimed. See *KSR Int’l Co. v. Teleflex, Inc.*, 127 S. Ct. 1727 (2007). In this regard, the Supreme Court further noted that “rejections on obviousness cannot be sustained by mere conclusory statements; instead, there must be some articulated

reasoning with some rational underpinning to support the legal conclusion of obviousness.” *Id.*, at 1396. Second, there must be a reasonable expectation of success. *In re Merck & Co., Inc.*, 800 F.2d 1091, 231 U.S.P.Q. 375 (Fed. Cir. 1986). Third, the prior art reference(s) must teach or suggest all of the claim features. *In re Royka*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.C.P.A. 1974).

As explained above, the “Rowley” reference is not effective prior art, since it is antedated by the present application’s U.S. national phase filing date of May 10, 2005, and since Rowley is only entitled to a filing date of September 6, 2006 as to the subject matter of paragraphs 37 to 42 asserted by the Examiner.

Accordingly, claim 20 is allowable.

In summary, all of pending claims 11 to 20 are allowable.

CONCLUSION

In view of the foregoing, it is respectfully submitted that all pending claims 11 to 20 are in condition for allowance. It is therefore respectfully requested that the rejections (and any objections) be withdrawn. Since all issues raised by the Examiner have been addressed, an early and favorable action on the merits is respectfully requested.

Respectfully submitted,
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